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10/732,908	12/11/2003	Jerome Swartz	7157-381CON	6921

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EXAMINER

PATEL, HEMANT SHANTILAL

ART UNIT PAPER NUMBER

2614

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/732,908

Applicant(s)

SWARTZ ET AL.

Examiner

Hemant Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____                                                            | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: The application disclosure indicates US Patent Application No. 08/654,961, filed May 29, 1995 but it differs from USPTO record filing date of May 29, 1996. The US Patent Application No. 09/571,618 and 09/240,399 should be referenced with their respective US Patent No.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 11 recites the limitation "said checkout terminal" in 10. There is insufficient antecedent basis for this limitation in the claim.

3. Claim 12 recites the limitation "said audible transceiver means" in 1. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 21 recites the limitation "said communications" in 1. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 26 recites the limitation "said transaction terminal" in 25. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 5,923,735.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than the ones in patent, *In re Van Ornum and Stang*, 214 USPQT61, broad claims in continuation application are rejected as obvious double patenting over previously patented narrow claims. For example, claims 1-28 of instant application claim the same features as recited in claims 1-28 of U.S. Patent No. 5,923,735 except the preamble of claim 1 of instant application is an actual limitation (a) of claim 1 of U.S. Patent No. 5,923,735. Moreover, the claims

1-28 of instant application are copy of originally presented and rejected claims 1-28 of US Patent No. 5,923,735.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-3, 7-10, 13-19, 21, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeAngelis (US Patent No. 4,654,482), and further in view of Johnston (UK Patent Application GB 2 246 491 A).

***Regarding claim 1***, DeAngelis teaches of a system for transferring information from a centrally located site to a portable communications terminal via a telephone network (Fig. 1, item 12; col. 7, ll. 31-36), said site comprised of a look up table

containing plurality of data records correlating to items disposed at a retail establishment (col. 7, ll. 54-56, transmitted items are compared against its data base), wherein each of said items has associated with it a bar code encoded with the indicia unique to said item (Fig. 1, items 40, 42, 44), with each said bar coded indicia corresponding to a particular record in said table (col. 7, ll. 58, description of item along with "today's" price), said information containing at least a portion of said record, the system comprising:

- a) a portable communications terminal (Fig. 1, item 10) comprising:
  - i) bar code reading means for optically reading a bar code located on an item and for generating a bar code data signal indicative of the identity of said item (Fig. 1, item 36).

DeAngelis does not teach of audible transducer means, a switch to select audible transducer means or bar code scanning means, and transceiver to communicate via cellular network.

However, in the same field of endeavor, Johnston teaches of a cellular phone (Fig. 1, item 1) with a barcode reader (Fig. 1, item 8) and a switch (Fig. 1, item 5b, READ) to select bar code reader mode.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis to include audible transducer means, a switch to select audible transducer means or bar code scanning means, and transceiver to communicate via cellular network as taught by Johnston in order to conserve on power by not activating bar code reading mode all the time and to use the audible transducer

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and cellular telephone calling capability to converse with other parties to confirm before making purchases.

**Regarding claim 2**, DeAngelis teaches of a first memory for current transaction file (Fig. 1, item 62).

**Regarding claim 3**, DeAngelis teaches of description of items with prices (col. 7, ll. 58).

**Regarding claims 7, 8**, DeAngelis teaches the first memory (Fig. 1, item 62) is part of communication terminal (Fig. 1, item 10) (col. 6, ll. 30-47) and is associated with central site (col. 7, ll. 53-59, send the item from list in memory to central site and receive item description and price).

**Regarding claim 9**, DeAngelis teaches of central site with second memory with prior transaction files (col. 7, ll. 40-48, checking information about prior transactions).

**Regarding claim 10**, DeAngelis teaches of central site that includes updating means for updating a user's prior transaction file in accordance with the current file (col. 7, ll. 63-66, items being acknowledged and ordered).

**Regarding claim 13**, DeAngelis teaches of a visual display means (Fig. 1, item 94), wherein said information, transmitted from said central site to said portable communication terminal, is outputted to said user via said visual display means (col. 7, ll. 60-66).

**Regarding claim 14**, DeAngelis teaches of a visual display with touch screen (col. 8, ll. 24-25, screen-touch switching).

**Regarding claims 15, 16,** DeAngelis does not teach of a touch screen configured with different sets of control buttons and menus with one set used in bad code reading mode and another in communication mode.

However, in the same field of endeavor, Johnston teaches of touch screen with use programmable control buttons (depressing appropriate alphanumeric keys with menu or function key) (Fig. 1, item 5) for selection of relevant menu (set of keys appropriate for mode of operation) (Pg. 5, paragraph 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis to include user programmable buttons according to mode of operation as taught by Johnston in order to the user to access only functions that are associated with the respective mode that is being used at an instance so that incorrect buttons and hence functions are not used and thereby reduce malfunction and resulting confusion to a user.

**Regarding claim 17,** DeAngelis teaches of a display including LCD (col. 5, ll. 55-65).

**Regarding claim 18,** DeAngelis teaches of a plurality of control keys ((Fig. 1, item 86).

**Regarding claim 19,** refer to rejections for claim 15 and claim 18.

**Regarding claim 21,** DeAngelis and Johnston do not teach of suspending communication between portable terminal and central site and enabling communications between the terminal and selected destination.



It is well known in the art to suspend, the current communication between a terminal and its conversing partner, by using hook flash and dialing another destination to establish another communication and then reestablish the original communication.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis and Johnston to temporarily suspend the existing communication session to establish another communication connection with hook-flash and dialing another destination as is well known in the art to consult with a third party about the shopping transaction being carried out.

**Regarding claims 25, 26,** DeAngelis teaches of each merchant providing transaction verification cartridges that transfer information to transaction terminal (col. 4, ll. 15-23; col. 6, ll. 64-col. 7, ll. 68, transactions verified).

**Regarding claim 27,** DeAngelis teaches of a display including LED (col. 5, ll. 55-65).

**Regarding claim 28,** DeAngelis teaches of a plurality of control keys ((Fig. 1, item 86).

11. Claims 4-6, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeAngelis and Johnston as applied to claims 3, 10 above, and further in view of Ruppert (US Patent No. 5,424,524).

**Regarding claims 4, 5, 6,** DeAngelis and Johnston do not teach of a retail establishment checkout terminal receiving and displaying user's selected item information and adjusting and updating this information.

However, in the same field of endeavor, Ruppert teaches of retail establishment checkout terminal receiving and displaying (Fig. 5, step 108; col. 11, ll. 11-26, checkout clerk physically checking each item against downloaded and hence displayed item) and makes necessary correction (adjusting) (col. 11, ll. 25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis and Johnston to transfer list of user selected items and verify and adjust the selected shopping list as taught by Ruppert in order to provide better customer service with speedy checkout processing while accommodating shopper's last minute changes in shopped items.

***Regarding claim 11,*** DeAngelis and Johnston do not teach of a checkout terminal.

However, in the same field of endeavor, Ruppert teaches of retail establishment checkout terminal (Fig. 1, Personal Scanner works in conjunction with store checkout terminal to provide checkout of shopped items and functions as checkout terminal i.e. scanning, displaying items, showing purchase total) receiving prior transaction file that was updated with user's prior purchase (col. 11, ll. 27-68).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis and Johnston to receive prior transaction file as taught by Ruppert in order to enable comparison shopping as well as remind user of items generally shopped at a particular store.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeAngelis and Johnston as applied to claim 1 above, and further in view of Gorog (US Patent No. 4,947,028).

**Regarding claim 12,** DeAngelis and Johnston do not teach of outputting item information via audible transceiver means.

However, in the same field of endeavor, Gorog teaches of outputting information via synthesized speech (col. 5, ll. 8-10).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis and Johnston to output information via speech as taught by Gorog in order to communicate and confirm with handicapped shopper and confirm with the laws related to individuals with disabilities act.

13. Claims 20, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeAngelis and Johnston as applied to claim 1 above, and further in view of Shepard (US Patent No. 5,015,833).

**Regarding claims 20, 22, 23,** DeAngelis teaches of a scanning module that can be replaced (Fig. 1, item 36) and Johnston teaches of scanning module that can be external to cellular phone (pg. 8, paragraph 3).

DeAngelis and Johnston do not teach of laser scanning device.

However, in the same field of endeavor, Shepard teaches of a portable modular laser scanning device (Fig. 4, item 11) with an interface (Fig. 4, item 15) to a terminal

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(Fig. 4, item 101) and is equipped with a replaceable re-chargeable battery (col. 5, ll. 64-col. 5, ll. 4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis and Johnston with a laser scanner with re-chargeable battery as taught by Shepard in order to enable servicing of scanning components easy by connecting and disconnecting scanner easily and save the cost of power by using re-chargeable battery as opposed to costly disposable batteries as is well known in the art.

***Regarding claim 24,*** DeAngelis and Johnston do not teach of replaceable rechargeable power supply. Shepard teaches of replaceable rechargeable power supply.

DeAngelis, Johnston and Shepard do not teach of power supply comprising bar code reading means.

However, it is known in the art for cellular phones to have a detachable power supply module so that one can replace fresh charged power supply to cellular phone to use it continuously for longer period time as well as to replace defective power supply easily.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DeAngelis, Johnston and Shepard to use a power supply incorporating scanner so that a defective scanner also can be replaced easily just as replacing a power supply module. Moreover, the compact design of cellular phones provided limited interface for external device attachment.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,253,345 Fernandes

US patent No. 4,897,865 Canuel

US Patent No. 5,294,782 Kumar

US patent No. 5,468,948 Koenck

US patent No. 5,579,487 Meyerson

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 2614

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